

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Patent Application of:

First Named Inventor: John W. SAFIAN

Art Unit: 3754

Application No.: 10/751,367

Examiner: Philippe DERAKSHANI

Filing Date: January 5, 2004

Confirmation No.: 2205

For: MULTILAYER CONTAINER  
PACKAGE FOR DISPENSING A LIQUID  
PRODUCT

\* \* \*

**AFFIDAVIT OF JODI L. YINGLING**

1. In a License Agreement dated October 7, 2004, Patent Owner granted to a Licensee a license to a number of patents and patent applications including U.S. Patent Application No. 10/751,367 ("the Patent Application").

2. Under the License Agreement, if Patent Owner declined to continue to prosecute the Patent Application, it had an obligation to notify Licensee before any applicable deadline, among other obligations.

3. Patent Owner was aware of the USPTO requirement to respond to the Office Action dated June 22, 2006 for the Patent Application.

4. Patent Owner received from patent counsel communication via e-mail dated July 3, 2006 advising of the Office Action dated June 22, 2006 (copy of communication attached).

5. Patent Owner discussed, via e-mail, the USPTO's response deadline for the Patent Application, among other things (copy of discussion thread attached).

6. The discussion participants included Jodi Yingling, John Tobias, John Denner, Peter Kirchoff, and Evaristo Gonzalez, who were employed by Patent Owner or a related entity.

7. Based on incomplete information during the discussion, Applicant mistakenly chose not to respond.

8. I am currently employed by Patent Owner or a related entity as Intellectual Property & Technology Transfer Manager. I participated in the discussions referenced above.

9. Due to error, Patent Owner was not aware when it conducted its discussions that the Patent Application was subject to the obligations of the License Agreement concerning prosecution of pending patent applications. Patent Owner did not intend to fail its obligations in the License Agreement concerning prosecution of pending patent applications.

10. Patent Owner recently learned of the above-mentioned error.

11. Accordingly, the entire delay, from the due date for filing a response to the outstanding Office Action dated June 22, 2006 for the above-captioned application up through today, was unintentional.

12. I swear or affirm that the above statements are true and correct to the best of my knowledge and acknowledge that willful false statements or the like are punishable by fine and imprisonment under 18 U.S.C. 1001, and that such willful false statements may jeopardize the validity and enforceability of the patent.

Jodi L. Yingling  
Jodi L. Yingling

6-28-07  
Date

State of Pennsylvania :  
: ss.

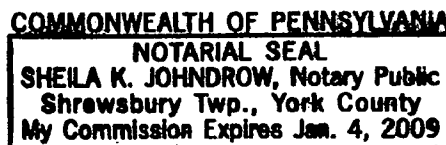
County of York :

Before me personally appeared said Jodi L. Yingling and acknowledged the foregoing instrument to be her free act and deed this 28<sup>th</sup> day of June, 2007.

Sheila K. Johndrow  
Notary Public

My commission expires: 01-04-09

(Notarial  
Seal)



Pete Kirchoff Comments

-----Original Message-----

From: Kirchoff, Peter

Sent: Tuesday, August 22, 2006 1:49 PM

To: 'Flandro, Ryan M.'; Gonzalez, Evaristo

Cc: Yingling, Jodi; 'Smith, Stuart I.'

Subject: RE: GRM17698MX - MULTILAYER CONTAINER PACKAGE FOR DISPENSING A LIQUID PRODUCT - Office Action Received in Mexico

Ryan, I left you a voice mail message just now. I'm going to go ahead and respond. If I am off base with my premises, please return my call and we can talk about it further.

As you pointed out, application 10/105,730 is a division of patent 6,719,173. Although the patent does mention squeezing, also as you pointed out, it still appears to me that the divisional application is attempting to include claims relative to the squeezable BIAB package we had under development at the time. I don't know this for sure, but everything seems to point in this direction. Specifically the language around controlling air egress appears to be new and relates very strongly to the development work.

I am struck by the way the examiner rejected the arguments made on March 30, 2006. In non-legal terms, I believe that "he just doesn't get it".

Regardless, having read all of the actions taken to date, I agree with you that a Request for Reconsideration is unlikely to be successful. While we could file an appeal, I am not sure that this activity is worthwhile for the following reasons:

The development work bogged down when we tried to determine how to drill a hole in the outside rigid bottle but not penetrate the inner bag. Further, our review of the IP around this revealed that Yoshino (and possibly others) had significant IP space around this activity, forcing us to probably license the technology in addition to having to purchase expensive equipment to do it.

The development work was initiated by two large customers at nearly the same time. Therefore, it seemed like there was significant commercial interest. Since then, going on several years now, I am not aware of any follow up interest or other activity in the market. Therefore, I don't see the value in continuing with any further action.

As for the Mexico office action, it is my opinion that we should take Stuart Smith's suggestion to cancel the claims from the US divisional application and elect the claims copied from the '173 patent. This obviously concludes from abandoning the divisional application as discussed above.

I will discuss these opinions internally and we will get back to you with a final decision. The point of getting this out now was to assure that I have the facts straight. Please advise.

Regards,

Peter Kirchoff  
Graham Packaging Company  
Personal Care & Specialty Business Unit  
New Product Development and Decoration Engineering  
Tel 717.505.6444

Further explanation from Ryan Flandro

-----Original Message-----

From: Flandro, Ryan M. [mailto:RMFlandro@Venable.com]  
Sent: Tuesday, July 18, 2006 4:27 PM  
To: Kirchoff, Peter; Gonzalez, Evaristo; Denner, John  
Cc: Smith, Stuart I.; Yingling, Jodi  
Subject: RE: GRM17698-01US (Our Ref: 29953.209868) - Response Filed 03-30-2006

Peter, Ever, and John:

In response to Peter's email of July 12, 2006, please find the attached previously filed responses dated October 3, 2005, and March 30, 2006. These documents should assist in your review of the final office action of June 22, 2006. Specifically, note that the currently pending claims (1-20) are listed in the response filed 10/3/05 and include all amendments to the original claims as well as all added claims. The particular arguments to which the Examiner is responding in the "Response to Arguments" section are set forth in the response filed 3/30/06.

We would also like to point out several important details to keep in mind.

First, remember that the instant application is a divisional application of a prior application (now U.S. Patent No. 6,719,173) and, as such, only includes claims directed specifically to the embodiment shown in FIGS. 1-4. The second embodiment (i.e., the BIAB with one-way valve shown in FIGS. 5-17) is covered by the '173 patent.

Second, with regard to the noted "squeezable" difference between the instant BIAB and the cited prior art references, the functional recitation in the last clause of each dependent claim (i.e., claims 1, 6, and 11) includes squeezing of the sidewall of the outer shell. It is this functional recitation that we have focused our arguments on and we can further stress the "squeezable" nature of BIAB in any response that we file, including an appeal brief.

Please feel free to contact me if you need anything else.

Regards,

Ryan

Ryan M. Flandro  
VENABLE LLP  
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Washington, DC 20004-1601  
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Fax: 202.344.8300  
<http://www.venable.com>  
[rmflandro@venable.com](mailto:rmflandro@venable.com)

Instructions to abandon Evar/Pete K  
Patent=GRM17698-01US

-----Original Message-----

From: Denner, John  
Sent: Thursday, July 06, 2006 5:00 PM  
To: Gonzalez, Evaristo  
Cc: Yingling, Jodi; Tobias, John; 'Smith, Stuart I.'; Denner,

John

Subject: FW: GRM17698-01US (Our Ref: 29953.209868) - Office

Action

Evar, you and your team are much closer to the 'bag in a bottle' technology and can best critique the office action below related to the John Safian invention. Please review the information and let us know your thoughts. I included a copy of the 'Richter' patent (Coca-Cola) for your benefit.

Thanks, John

-----Original Message-----

From: Smith, Stuart I. [<mailto:SISmith@Venable.com>]  
Sent: Monday, July 03, 2006 11:07 AM  
To: Yingling, Jodi  
Cc: Flandro, Ryan M.; St. John, Theresa R.  
Subject: GRM17698-01US (Our Ref: 29953.209868) - Response Filed

03-30-2006

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Action Requested: Provide Instructions for Responding to  
Final Office Action

Response by: August 22, 2006

July 3, 2006

Jodi Yingling

Supervisor, Legal Services - Intellectual Property

Graham Packaging Company, L.P.  
VIA E-MAIL

2401 Pleasant Valley Road

York, PA 17402

RE: Docket No.: GRM17698-01US

Atty Docket No.: 29953-209868

Title:  
MULTI-LAYER CONTAINER PACKAGE FOR DISPENSING A LIQUID PRODUCT

Application Type: US-Utility

Status: Pending

Priority App. No: 10/105,730,  
filed 3/25/2002, now Patent No. 6,719,173

Application No:  
10/751,367, filed 1/5/2004

Patent No.

Expiration date:

Published App. No. 2004-0134934 A1,  
published 07-15-2004

PCT Filing Date:

Int. Atty/Ext. Atty: SIS/RMF

Assignee: GPPP

Next Deadline: September 22, 2006

Dear Jodi:

Further to our email of April 19, 2006, the Examiner has now issued a final Office Action on the merits of the claims in this application dated June 22, 2006. A copy of the Office Action is enclosed. The Inventor is John Safian.

On page 2 of the Office Action, the Examiner has rejected claims 1, 5-12, and 15-17 as being anticipated by U.S. Patent No. 5,242,085 to Richter et al. ("Richter"). On pages 2-3, claims 2, 4, 12, 14, and 18-20 are rejected as being obvious in view of Richter. On page 3, claims 3 and 13 are rejected as being obvious in view of Richter and U.S. Patent No. 5,125,534 to Rose et al. ("Rose"). The Examiner's response to our arguments is set forth in the last paragraph on page 3.

As you know, we have several choices since the Examiner has made the rejections in the Office Action final. First, if you believe that the Examiner is incorrect and no substantive amendments are necessary to overcome the applied references, we can file a Request for Reconsideration asking the Examiner to reconsider the rejection. Given the Examiner's prior responses to our arguments, this is not likely to result in allowance of the application. Second, we can file a Request for Continued Examination (RCE) with an Amendment that amends



the claims to further distinguish over the cited references. As you know, amendments after a final rejection are entered at the discretion of the Examiner and an RCE is generally necessary to obtain entry of substantive amendments. Third, we can appeal the Examiner's rejections to the Board of Patent Appeals and Interferences by filing a Notice of Appeal. An Appeal Brief would be filed two months after filing the Notice of Appeal. Please note that the Patent Office has recently instituted a pre-appeal brief conference pilot program wherein a panel of examiners reviews the propriety of the rejection prior to the time an appeal brief is required. The review can yield several different results including allowance, the need to file an appeal brief, or a withdrawal of the rejection and a reopening of prosecution on the merits. Let us know if this is of interest to you, as it may help to reduce or avoid the costs associated with drafting and filing an appeal brief.

Should you wish to continue pursuing this application, we suggest filing an Appeal. Although there is no guarantee that this will lead to allowance of the application, we believe that there are valid arguments in favor of reversing the Examiner's rejection. Please review the Office Action in view of our comments and let us have your instructions.

The response is currently due to be filed by September 22, 2006, but this date can be extended for up to three months, i.e., December 22, 2006, upon payment of the applicable extension fee, which increases monthly. No extensions are permitted beyond December 22, 2006. Please note that there are certain advantages in filing a response within two (2) months of the date of a final rejection. Therefore, please let us have your instructions by August 22, 2006, if possible.

Please continue to send us any references that should be brought to the attention of the Examiner. At this stage of the prosecution, the Examiner will consider only prior art references that are filed within three months of first becoming known, e.g., cited for the first time in an Office Action or Search Report in any counterpart foreign application, and upon payment of a \$180.00 fee. Therefore, let us have any such prior art as soon as possible.

We look forward to receiving your instructions. In the meantime, if you have any questions, please feel free to contact us.

Sincerely yours,

Stu

**POWER OF ATTORNEY TO PROSECUTE APPLICATIONS BEFORE THE USPTO**

I hereby revoke all previous powers of attorney given in the application identified in the attached statement under 37 CFR 3.73(b).

I hereby appoint:

☒ Practitioners associated with the Customer Number:

00181

OR

☐ Practitioner(s) named below:

Name	Registration Number

as attorney(s) or agent(s) to represent the undersigned before the United States Patent and Trademark Office (USPTO) in connection with any and all patent applications assigned only to the undersigned according to the USPTO assignment records or assignment documents attached to this form in accordance with 37 CFR 3.73(b).

Please change the correspondence address for the application identified in the attached statement under 37 CFR 3.73(b) to:

☒ The address associated with Customer Number:

OR

00181

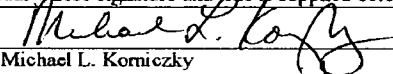
<input type="checkbox"/> Firm or Individual Name					
Address					
City		State		Zip	
Country					
Telephone			Email		

Assignee Name and Address:  
Graham Packaging Company, L.P.  
2401 Pleasant Valley Road  
York, PA 17402

A copy of this form, together with a statement under 37 CFR 3.73(b) (Form PTO/SB/96 or equivalent) is required to be filed in each application in which this form is used. The statement under 37 CFR 3.73(b) may be completed by one of the practitioners appointed in this form if the appointed practitioner is authorized to act on behalf of the assignee, and must identify the application in which this Power of Attorney is to be filed.

**SIGNATURE of Assignee of Record**

The individual whose signature and title is supplied below is authorized to act on behalf of the assignee

Signature		Date	6/21/07
Name	Michael L. Korniczky	Telephone	(717) 849-8634
Title	Vice President and General Counsel		

☐ \*Total of \_\_\_\_\_ forms are submitted.

This collection of information is required by 37 CFR 1.31, 1.32 and 1.33. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 3 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

**STATEMENT UNDER 37 CFR 3.73(b)**

Applicant/Patent Owner: Graham Packaging Company, L.P.

Application No./Patent No./Control No.: 10/751,367 Filed/Issue Date: January 5, 2004

Entitled: **MULTILAYER CONTAINER PACKAGE FOR DISPENSING  
A LIQUID PRODUCT**

Graham Packaging Company, L.P., a Corporation

(Name of Assignee)

(Type of Assignee: corporation, partnership, university, government agency, etc.)

states that it is:

1. ☒ the assignee of the entire right, title, and interest; or  
2. ☐ an assignee of less than the entire right, title and interest  
(The extent (by percentage) of its ownership interest is \_\_\_\_\_%)

in the patent application/patent identified above by virtue of either:

- A. ☒ An assignment from the inventor(s) of the patent application/patent identified above. The assignment was recorded in the United States Patent and Trademark Office at Reel 017946, Frame 0345, or a true copy of the original assignment is attached.

OR

- B. ☐ A chain of title from the inventor(s), of the patent application/patent identified above, to the current assignee as follows:

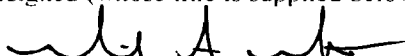
1. From: \_\_\_\_\_ To: \_\_\_\_\_  
The document was recorded in the United States Patent and Trademark Office at  
Reel \_\_\_\_\_, Frame \_\_\_\_\_, or for which a copy thereof is attached.  
2. From: \_\_\_\_\_ To: \_\_\_\_\_  
The document was recorded in the United States Patent and Trademark Office at  
Reel \_\_\_\_\_, Frame \_\_\_\_\_, or for which a copy thereof is attached.  
3. From: \_\_\_\_\_ To: \_\_\_\_\_  
The document was recorded in the United States Patent and Trademark Office at  
Reel \_\_\_\_\_, Frame \_\_\_\_\_, or for which a copy thereof is attached.

- ☐ Additional documents in the chain of title are listed on a supplemental sheet.

As required by 37 CFR 3.73(b)(1)(i), the documentary evidence of the chain of title from the original owner to the assignee was, or concurrently is being, submitted for recordation pursuant to 37 CFR 3.11.

[NOTE: A separate copy (i.e., a true copy of the original assignment document(s)) must be submitted to Assignment Division in accordance with 37 CFR Part 3, to record the assignment in the records of the USPTO. See MPEP 302.08]

The undersigned (whose title is supplied below) is authorized to act on behalf of the assignee.

  
Signature

July 19, 2007

Date

Michael A. Minter, Registration No. 58,797  
Printed or Typed Name

703-610-8646  
Telephone Number

\_\_\_\_\_  
Title